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10/828,991	04/21/2004	David M. Hilbert	FX/A3024	5500
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/828,991

Applicant(s)

HILBERT ET AL.

Examiner

LUU PHAM

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
4a) Of the above claim(s) 85-90 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-84 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-850)
Paper No(s)/Mail Date 04/08/2005 and 02/09/2005
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the communication filed on 04/23/2008.
2. In response to the restriction requirement, the Applicant has elected group 1, claims 1-84, without traverse for prosecution. Claims 1-84 have been examined and are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 29-56 are rejected under 35 U.S.C. 101** because the claims may be directed to non-statutory subject matter.

- **Regarding claim 29**, although the preamble of the claim recites “*A system for sharing files with remote users,*” the body of the claim may be directed to software implementation since “*a proxy database*” is implemented by software as described in the paragraph [0069] of the specification: “*included in the programming (software) of the general/specialized computer or microprocessor are software modules for implementing the teachings of the present invention.*” (Emphasis added).

- **Regarding claims 30-56**, claims 30-56 are also rejected as nonstatutory under 35 U.S.C 101 as they do not belong to any of the four categories set forth above.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-28 and 57-84 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- **Regarding claims 1 and 57**, the claims recite the phrase “*generating a proxy representation for the file, the proxy representation associated with the remote user and storing a location of the file;*” (emphasis added). This is vague in reference to how the proxy representation stores a location of the file. For the purpose of applying art, the examiner interprets the aforementioned phrase to mean “*generating a proxy representation for the file, the proxy representation associated with the remote user and storing location information of the file;*” (emphasis added). Appropriated corrections are required.

- **Regarding claims 2-28 and 58-84**, claims 2-28 and 58-84 are dependent on claim 1 and 57 respectively, and therefore inherit the 35 U.S.C 112, second paragraph issues of the independent claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-8, 11-16, 19-36, 39-44, 47-64, 67-72, and 75-84 are rejected under 35 U.S.C. 102(e)** as being anticipated by Gong, U.S. Patent Publication No. 2004/0064733, filed on June 26, 2003.

- **Regarding claim 1**, Gong discloses a method for sharing files with remote users (*par. 0009; Fig. 2*), the method comprising:
 - accepting a request from a file sharer to share a file with a remote user (*pars. 0009, 0020, and 0029; Fig. 2; user sends emails with attachments through email client interface*);
 - accessing credentials, the credentials configured to enable access to the file (*pars. 0009, 0030, and 0033; users can access the Client Project Information Management Web Interface to manage attachment information; login authentication is needed*); and
 - generating a proxy representation for the file, the proxy representation associated with the remote user and storing a location of the file (*pars. 0009, 0031, and 0034; a unique attachment descriptor and locator will be generated to identify the save attachment; a version controlled copy of the original attachment from the IMS*).

- **Regarding claim 2**, Gong discloses the method of claim 1, wherein accessing the credentials comprises accepting the credentials from the file sharer (*pars. 0009 and 0033; users can access and change the environment setting by login through Client Information Management Web Interface*).

- **Regarding claim 3**, Gong discloses the method of claim 1, wherein accessing the credentials comprises retrieving previously stored credentials (*pars. 0009 and 0033*).

- **Regarding claim 4**, Gong discloses the method of claim 1, further comprising using the credentials to store a cached copy of the file in association with the proxy representation (*pars. 0009, 0031, and 0033-0036*).

- **Regarding claim 5**, Gong discloses the method of claim 1, further comprising storing the credentials in association with the proxy representation (*par. 0009 and 0034; permission to access the Client Information Management Web Interface will be administrated by the original email creator; IMS will manage and log all check-in, checkout and modification activities related to the attachment*).

- **Regarding claim 6**, Gong discloses the method of claim 1, further comprising: accepting a view request from the remote user (*pars. 0009 and 0035-0036; Fig. 2*); and enabling the remote user to view the file (*pars. 0009 and 0036; Fig. 2*).

- **Regarding claim 7**, Gong discloses the method of claim 1, further comprising: accepting a share request from the remote user (*pars. 0009, 0020-0021, and 0029; Fig. 2; mail client sends a messages with attachment to a recipient*); and enabling the remote user to share the file with a third party (*pars. 0009, 0021-0023, 0031-0036; Fig. 2; recipient gets the message and requires downloading the attached file(s)*).

- **Regarding claim 8**, Gong discloses the method of claim 1, further comprising: accepting an email request from the remote user (*pars. 0009 and 0029*); and transmitting an email associated with the file (*pars. 0009 and 0029*).

- **Regarding claim 11**, Gong discloses the method of claim 1, wherein the request comprises a request generated by:

- viewing a representation of the file within a graphical user interface (*pars. 0009 and 0029*; a dynamic link of all projects (attachment related) to which a user subscribed will be conveniently displayed on email or web-mail client interface);

- selecting the representation of the file within the graphical user interface (*pars. 0009 and 0029*; user sends emails with attachments through email client interface (Outlook, etc.) or web browser based web-mail client interface (Hotmail, etc.));

- viewing a menu associated with the file, the menu displaying actions that can be performed on the file (*pars. 0009 and 0029*); and

- selecting a share option from the menu (*pars. 0009 and 0029*).

- **Regarding claim 12**, Gong discloses the method of claim 1, wherein generating the proxy representation comprises generating a proxy representation configured to enable the remote user to modify the file (*pars. 0009, 0033-0034, and 0038*).

- **Regarding claim 13**, Gong discloses the method of claim 1, wherein generating the proxy representation comprises generating a proxy representation configured to enable the remote user to read the file (*pars. 0009, 0033-0034, and 0038*).

- **Regarding claim 14**, Gong discloses the method of claim 1, wherein storing credentials comprises accepting the credentials from the file sharer (*pars. 0009 and 0033*).

- **Regarding claim 15**, Gong discloses the method of claim 1, further comprising determining if a database entry associated with the remote user is stored on an account database (*pars. 0009, 0030, and 0033*).
- **Regarding claim 16**, Gong discloses the method of claim 15, further comprising storing the proxy representation in association with the database entry associated with the remote user in response to a positive determination (*pars. 0009 and 0029-0036; after successfully logging into user's email account, the user is able to either send email with attachments or downloading the attached file*).
- **Regarding claim 19**, Gong discloses the method of claim 1, further comprising accepting a retrieval request from the remote user (*pars. 0009 and 0035-0038*).
- **Regarding claim 20**, Gong discloses the method of claim 19, further comprising using the credentials to retrieve the file (*pars. 0009 and 0033-0037*).
- **Regarding claim 21**, Gong discloses the method of claim 19, wherein the retrieval request includes authentication information for the remote user (*pars. 0009 and 0033-0037*).
- **Regarding claim 22**, Gong discloses the method of claim 19, further comprising providing access to a cached version of the file (*pars. 0009 and 0036-0038*).
- **Regarding claim 23**, Gong discloses the method of claim 19, further comprising accepting a modification request from the remote user (*pars. 0009 and 0036-0038*).

- **Regarding claim 24**, Gong discloses the method of claim 23, wherein the modification request includes authentication information (*pars. 0009 and 0036-0038*).
- **Regarding claim 25**, Gong discloses the method of claim 23, further comprising using the credentials to modify the file (*pars. 0009 and 0036-0038*).
- **Regarding claim 26**, Gong discloses the method of claim 23, further comprising: modifying a cached version of the file in response to the modification request (*pars. 0009 and 0036-0038*); and notifying the file sharer that the cached version has been modified (*pars. 0009 and 0038; all users having rights to access the attachments will receive email notifications for any version or content update of a file*).
- **Regarding claim 27**, Gong discloses the method of claim 26, further comprising synchronizing the file with the cached version in response to a request from the file sharer (*pars. 0009 and 0036-0038*).
- **Regarding claim 28**, Gong discloses the method of claim 25, further comprising notifying the file sharer that the file has been modified (*pars. 0009 and 0038; all users having rights to access the attachments will receive email notifications for any version or content update of a file*).
- **Regarding claim 29**, Gong discloses a system for sharing files with remote users (*par. 0009; Fig. 2*), the system comprising:
 - a proxy database storing proxy representations, the proxy representations configured to enable access to files for remote users (*pars. 0009 and 0029-0031; Fig. 2*); and

a proxy configured to:

accept a request from a file sharer to share a file with a remote user (*pars. 0009, 0020, and 0029; Fig. 2; user sends emails with attachments through email client interface*);

access credentials, the credentials configured to enable access to the file (*pars. 0009, 0030, and 0033; users can access the Client Project Information Management Web Interface to manage attachment information; login authentication is needed*); and

generate a proxy representation for the file (*pars. 0009, 0031, and 0034; a unique attachment descriptor and locator will be generated to identify the save attachment; a version controlled copy of the original attachment from the IMS*).

- **Regarding claims 30-36**, claims 30-36 are similar in scope to claims 2-8, and are therefore rejected under similar rationale.

- **Regarding claims 39-44**, claims 39-44 are similar in scope to claims 11-16, and are therefore rejected under similar rationale.

- **Regarding claims 47-56**, claims 47-56 are similar in scope to claims 19-28, and are therefore rejected under similar rationale.

- **Regarding claim 57**, claim 57 is similar in scope to claims 1, and is therefore rejected under similar rationale.

- **Regarding claims 58-64**, claims 58-64 are similar in scope to claims 2-8, respectively, and are therefore rejected under similar rationale.

- **Regarding claims 67-72**, claims 67-72 are similar in scope to claims 11-16, respectively, and are therefore rejected under similar rationale.
- **Regarding claims 75-84**, claims 75-84 are similar in scope to claims 19-28, respectively, and are therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
11. **Claims 9-10, 37-38, and 65-66 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Gong, as applied to claims 1, 29, and 57 above, in view of Loveland et al., (hereinafter "Loveland"), U.S. Patent Publication No. 2003/0163515, published on August 28, 2003.

- **Regarding claim 9**, Gong discloses the method of claim 1.

Gong does not explicitly disclose accepting a print request from the remote user; and transmitting a print request associated with the file to a remote print service.

However, in an analogous art, Loveland discloses a method for managing the exchange of files attached to electronic mails, wherein accepting a print request from the remote user (*pars. 0006 and 0040; Figs. 3-4; document-inclusion operations may include, for example, the sending or forwarding of an e-mail with an attachment, the sending or responding to a meeting request with a calendar attachment, printing a document over a network, faxing a document over a network, or the like*); and transmitting a print request associated with the file to a remote print service (*pars. 0006 and 0040; Figs. 3-4; the server 220 performs document-inclusion operations on behalf of the client*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Loveland with the method and system of Gong, wherein accepting a print request from the remote user; and transmitting a print request associated with the file to a remote print service to provider users with a means for effectively performing 'document-inclusion' operations over a network while preserving the network bandwidth of the network (*par. 0010*).

- **Regarding claim 10**, Gong discloses the method of claim 1.

Gong does not explicitly disclose accepting a fax request from the remote user; and transmitting a fax request associated with the file to a remote fax service.

However, in an analogous art, Loveland discloses a method for managing the exchange of files attached to electronic mails, wherein accepting a fax request from the remote user (*pars. 0006 and 0040; Figs. 3-4; document-inclusion operations may include, for example, the sending or forwarding of an e-mail with an attachment, the sending or responding to a meeting request with a calendar attachment, printing a document over a network, faxing a document over a network, or the like*); and transmitting a fax request associated with the file to a remote fax service (*pars. 0006 and 0040; Figs. 3-4; the server 220 performs document-inclusion operations on behalf of the client*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Loveland with the method and system of Gong, wherein accepting a fax request from the remote user; and transmitting a fax request associated with the file to a remote fax service to provider users with a means for effectively performing 'document-inclusion' operations over a network while preserving the network bandwidth of the network (*par. 0010*).

- **Regarding claims 37-38**, claims 37-38 are similar in scope to claims 9-10, respectively, and are therefore rejected under similar rationale.
 - **Regarding claims 65-66**, claims 65-66 are similar in scope to claims 9-10, respectively, and are therefore rejected under similar rationale.
12. **Claims 17-18, 45-46, and 73-74 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Gong, as applied to claims 1, 29, and 57 above, in view of Jhingan et al., (hereinafter "Jhingan"), U.S. Patent Publication No. 2004/0186851, filed on March 21, 2003.

- **Regarding claim 17**, Gong discloses the method of claim 15.

Gong does not explicitly disclose generating a new database entry associated with the proxy representation for the remote user in response to a negative determination.

However, in an analogous art, Jhingan discloses a method for email attachment distribution, wherein generating a new database entry associated with the proxy representation for the remote user in response to a negative determination (*par. 0057; in situation where the recipient system 102 does not exists, then a new user profile is created for which the user can submit a password and preferred location for future deliveries*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Jhingan with the method and system of Gong, to include generating a new database entry associated with the proxy representation for the remote user in response to a negative determination to provide user with a means for enabling collaboration through large email attachment (*par. 0008*).

- **Regarding claim 18**, Gong and Jhingan disclose the method of claim 17.

Jhingan further discloses transmitting an email containing a registration key to the remote user (*par. 0034; the locator object may be embedded as a linked object with the email and sent to a recipient system 102; the attachment associated with the locator code may be downloaded from a server to the recipient system 102*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Jhingan with the method and system of Gong, to include transmitting an email containing a registration key to the remote user to

provide user with a means for enabling collaboration through large email attachment (*par. 0008*).

- **Regarding claims 45-46**, claims 45-46 are similar in scope to claims 17-18, respectively, and are therefore rejected under similar rationale.

- **Regarding claims 73-74**, claims 73-74 are similar in scope to claims 17-18, respectively, and are therefore rejected under similar rationale.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Publication No. US 2005/0076082 by Le Pennee et al.

U.S. Patent Publication No. US 2003/0101200 by Koyama et al.

U.S. Patent Publication No. US 2003/0023725 by Bradfield et al.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luu Pham whose telephone number is 571-270-5002. The examiner can normally be reached on Monday through Friday, 7:30 AM - 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Luu Pham/
Examiner, Art Unit 2137

/Nasser G Moazzami/
Supervisory Patent Examiner, Art Unit 2136